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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Robert M. Zeidman

Examiner: Schnurr, John R.

Serial No.: 09/767,819

Group Art Unit: 2623

Filed: January 22, 2001

Docket: Zeid-02

For: Method For Advertisers to Sponsor Broadcasts Without Commercials

REPLY BRIEF UNDER 37 CFR § 41.41

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is presented in support of the Notice of Appeal to the Board of Patent Appeals and Interferences filed on March 31, 2009, the Appeal Brief filed on June 8, 2009 and in response to the Examiner's Answer mailed on September 10, 2009.

The Appellant respectfully requests consideration and reversal of the Examiner's rejections of the claims on appeal.

1. TABLE OF AUTHORITIES

The following authorities are relied upon in the Appeal Brief and in this Response Brief.

KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727, 82 U.S.P.Q.2d 1385 (2007).

Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17 (1966).

In re Kahn, 441 F. 3d 977, 988 (Fed. Cir. 2006).

In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976).

Dann v. Johnston, 425 U.S. 219, 189 USPQ 257 (1976).

In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

In re Royka, 490 F.2d 981 (CCPA 1974).

35 U.S.C. §103.

M.P.E.P. § 2142-§ 2144.

2. STATEMENT OF ADDITIONAL FACTS

There are no additional facts known to Appellant that will have a bearing on the Board's decision in the present appeal.

3. ARGUMENT

A) The Responses Provided By the Examiner in the Examiner's Answer Are Not Supported By the Cited Art and Insufficient to Support Rejection of the Claims on Appeal -

The Examiner asserts the following in the first Response to Argument on page 7-8 of the Examiner's Answer.

1. ... Matheny does disclose a system for encouraging users to pay attention to commercials, however, Matheny further discloses the communication system 200 "reward[s] viewers for paying attention to broadcast television commercials and other types of broadcast programs" (col. 2 lines 38-42). Another type of broadcast television program known to one of ordinary skill in the art at the time of the invention, as shown by Schindler's List, is a commercial free program funded by a sponsor.

In response to this assertion, the Applicant respectfully submits the following comments. The Examiner has extended the interpretation of, "other types of broadcast programs" to include, "commercial free program funded by a sponsor." Firstly, it is important to note that there is no support or suggestion for this Examiner-applied interpretation found in Matheny. This specific interpretation of Matheny comes from the Examiner's attempt to make the reference fit, not from any particular teaching signaled by Matheny. Secondly, this interpretation, if reasonably applied to the teachings of Matheny, would still be distinguishable from the embodiments claimed by the Appellant. As described in Matheny, "viewers must provide some feedback to indicate that they watched the commercial before they are entitled to a reward." See Matheny, col. 3, lines 14-30, emphasis added. As such, Matheny teaches a system implemented to require such prompted viewer feedback from the viewer as part of viewer participation in an interactive reward program. If, as the Examiner suggests, we interpret this portion of Matheny to apply to a, "commercial free program funded by a sponsor," we would still have a system in which, "viewers must provide some feedback to indicate that they watched the [commercial free program funded by a sponsor] before they are entitled to a reward." As such, Matheny would motivate one of ordinary skill in the art to insert some kind of prompted viewer feedback mechanism into the alleged commercial free program funded by a sponsor. Such an

implementation is the only logical application of the Examiner-applied interpretation to the teachings of Matheny. This implementation of required viewer feedback in Matheny is directly opposite to and inconsistent with the approach presently claimed, wherein the pending claims specifically recite that, "viewer information is not collected in response to prompted viewer feedback". Therefore, the Examiner's First Response is both unsupported by the cited art and insufficient to support rejection of the claims on appeal.

B) The Responses Provided By the Examiner in the Examiner's Answer Assert a Combination of References that are Inconsistent with the Intent and Implementation of the Cited References -

The Examiner asserts the following in the second Response to Argument on page 8 of the Examiner's Answer.

2. ... Matheny discloses obtaining viewing information and based on the amount of a program viewed providing a reward to the user. Williams discloses two methods for obtaining viewing information and providing rewards based on the viewing information, the first being a survey in which users are prompted for feedback, and the second being a passive monitoring system in which the user is not prompted for feedback (col. 2 lines 3-10; col.5 line 63 to col. 6 line 5). The two viewing information obtaining methods are interchangeable and therefore one of ordinary skill in the art at the time of the invention would have been motivated to replace the "prompting" information collection method of Matheny with the passive information collection method of Williams in order to provide a less intrusive viewing experience.

In response to this assertion, the Applicant respectfully submits the following comments. The Examiner has attempted to combine the prompted information collection method of Matheny with the passive information collection method of Williams. However, this alleged combination is a mismatch that runs counter to the intent and implementation of both Matheny and Williams. As explained above, Matheny is clearly and strongly focused on providing functionality to require user feedback prior to awarding incentives. It would be inconsistent with this approach to suggest that Matheny could abandon this design goal in favor of a passive

information collection method. Moreover, it is not clear how Matheny's system could be modified, as the Examiner suggests, to implement a passive approach.

Williams is silent on providing specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the viewer. Williams is also silent on providing specific incentives including information indicative of one or more sponsors of the broadcast. The portions of Williams cited by the Examiner relate to Williams' passive collection of user preference information. This user preference information is collected for groups of users over time and over a viewing pattern of many programs to categorize users for targeted advertising. Thus, Williams is not focused on, and does not suggest, providing specific incentives to specific users for viewing all or a portion of a particular program by a particular sponsor. It would be inconsistent with the teachings in Williams to suggest that Williams could be altered to collect this specific information that the described implementation clearly could not use. This combination of Matheny and Williams offered by the Examiner is merely an attempt to force superficially similar references to fit the Examiner's hindsight reconstruction.

C) The Responses Provided By the Examiner in the Examiner's Answer Assert a Combination of References Not Supported by Any Teaching, Suggestion, or Motivation in the Cited Art -

The Examiner asserts the following in the third Response to Argument on pages 8-9 of the Examiner's Answer.

3. ... As discussed in section 2 above, Williams discloses substituting prompting a user for feedback with monitoring a user to obtain user behavior and as such the same information is collected, i.e. what the viewer watched, therefore the system of Matheny would still be able to reward viewers for programs watched as that information is available whether collected via prompting or monitoring

Matheny is directed at a system and method that requires some sort of viewer feedback as part of the reward validation and fulfillment process. As described in Matheny, "viewers must provide some feedback to indicate that they watched the commercial before they are entitled to a reward." As such, Matheny is designed and implemented to require such prompted viewer

feedback from the viewer as part of viewer participation in an interactive reward program. Many of the operations in Matheny are triggered as a result of receiving the required viewer feedback. If such feedback was not forthcoming, Matheny would be rendered inoperable.

In Williams, the described implementation collects user preference information for groups of users to categorize users for targeted advertising. By its own description, Williams collects user preference information to provide coupons to a target audience (see Williams, col. 1, lines 31-39, emphasis added). The target audience is based on preferences of respective users. Thus, Williams is not focused on, does not suggest, and does not motivate providing specific incentives to specific users for viewing all or a portion of a particular program by a particular sponsor.

Thus, there is no teaching, suggestion, or motivation in the cited art that would have led one of ordinary skill in the art to produce the claimed invention from any combination of the teachings in the cited art. The presently claimed invention would not be a predictable result of any combination of the cited references. Therefore, the Examiner has failed to establish a proper *prima facie* case of obviousness by failing to demonstrate that the claimed invention is predictable, suggested, or motivated by the teachings in the cited references. Thus, reconsideration and reversal of the rejections under 35 USC § 103(a) is respectfully requested.

Summary

For the reasons set forth above, claims 1-10 have been improperly rejected under 35 USC § 103(a) as being unpatentable over any combination of Schindler's List, Matheny, Blackketter, and/or Williams. It is respectfully noted that if an independent claim is nonobvious under 35 USC § 103, then any claim depending therefrom is also nonobvious. See M.P.E.P. § 2143.03. Thus, the independent and the dependent claims presently presented are not obvious for the reasons set forth above and in the previously filed Appeal Brief. As explained and supported in this Appeal, the pending claims were improperly rejected. The Applicant therefore respectfully requests reversal of the rejections under 35 USC § 103(a) and allowance of the pending claims.

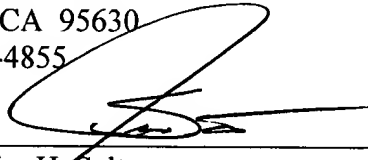
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 10th day of November, 2009.

Jim H. Salter

Name



Signature



REPLY BRIEF UNDER 37 C.F.R. § 41.41

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